

REMARKS

Claims 1-27 are pending.

Claim 19 stand objected to because of informalities.

Claims 1-10, 12-23, 25-27 stand rejected under 35 USC §102(e) as being allegedly anticipated by *Lapstun* et al. (US Patent Number 6,946,672).

Claims 11 and 24 stand rejected under 35 USC §103(a) as being allegedly unpatentable over *Lapstun* et al. (US Patent Number 6,946,672) in view of *Denny, III* (US Patent Application Publication Number US 2004/0212586 A1).

Changes in the Specification:

The specification has been amended to correct informalities.

In the abstract, the paragraph label [0031] has been removed.

In the specification, “5A-C” have been replaced with “5A-5C” at paragraphs [0008], [0023], and [0024].

Changes in the Claims:

Claims 1, 6, 12, 17, 19, and 23 have been amended in this application to further particularly point out and distinctly claim subject matter regarded as the invention. No new matter has been added.

Rejection under 35 USC §102(e) – claims 1-10, 12-23, 25-27

Claims 1-10, 12-23, 25-27 stand rejected under 35 USC §102(b) as being allegedly anticipated by *Lapstun* et al. (US Patent Number 6,946,672). This rejection is respectfully traversed.

A claim must be anticipated for a proper rejection under §102(a), (b), and (e). This requirement is satisfied “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”; see MPEP §2131 and *Verdegaal Bros. V. Union Oil*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1984). A rejection under §102(b) may be overcome by showing that the claims are patentably distinguishable from the prior art; see MPEP §706.02(b).

Lapstun describes a viewer that includes a code sensor that “senses tags” on a page. The viewer displays according to the information from the tags.

In contrast, the claims recite in part “tracking the movement of the computer system via physical contact with a surface; and correlating the tracked movement of the computer system to an indicator on the display of the computer system.” *Lapstun* tracks any movement via the tags on a paper and not via physical contact with a surface. As such, *Lapstun* does not teach or suggest “tracking the movement of the computer system via physical contact with a surface.”

The presently claimed invention is, accordingly, distinguishable over the cited reference. In the view of the foregoing, it is respectfully asserted that claims 1-10, 12-23, 25-27 are now in condition for allowance.

Rejection under 35 USC §103(a) – claims 11 and 24

Claims 11 and 24 stand rejected under 35 USC §103(a) as being allegedly unpatentable over *Lapstun* et al. (US Patent Number 6,946,672) in view of *Denny, III* (US Patent Application Publication Number US 2004/0212586 A1). This rejection is respectfully traversed.

Under MPEP §706.02(j), in order to establish a prima facie case of obviousness required for a §103 rejection, three basic criteria must be met: (1) there must be some suggestion or motivation either in the references or knowledge generally available to modify the reference or combine reference teachings (MPEP §2143.01), (2) a reasonable expectation of success (MPEP §2143.02), and (3) the prior art must teach or suggest all the claim limitations (MPEP §2143.03). See *In re Royka*, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974).

Applicant respectfully submits that the proposed combination of *Lapstun* and *Denny III* does not teach or suggest all of the claim limitations of claims of “tracking the movement of the computer system **via physical contact with a surface**; and correlating the tracked movement of the computer system to an indicator on the display of the computer system.”

Applicant therefore submits that the rejection based the *Lapstun* and *Denny III* reference be withdrawn. Thus, Applicant submits that claims 11 and 24 recite novel

subject matter which distinguishes over any possible combination of *Lapstun* and *Denny III*.

Conclusion

For all of the above reasons, applicants submit that the amended claims are now in proper form, and that the amended claims all define patentable subject matter over the prior art. Therefore, Applicants submit that this application is now in condition for allowance.

Request for allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

Invitation for a Telephone Interview

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.


Extension of Time

Pursuant to 37 C.F.R. 1.136(a)(3), applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

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